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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,594	08/31/2001	Teruo Akashi	60188-093	7454

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Jack Q. Lever, Jr.
McDERMOTT, WILL & EMERY
600 Thirteenth Street, N.W.
Washington, DC   20005-3096

EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/942,594	AKASHI, TERUO
		Examiner	Art Unit
		John M. Winter	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _02 April 2005_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-19_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-19_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _5/5/2005_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Claims 1-19 remain pending.

Response to Arguments

The Applicant's arguments filed on April 1, 2005 have been fully considered but are not persuasive.

The Applicant claims that the feature of "verification means for verifying the validity of a license storing device carried by a user by performing mutual verification between the license storing device and the contents reproducing device, without authentication of the user" is not disclosed by the prior art references of Runje and Clark.

The examiner responds that the Clark ('280) reference discloses verification means for verifying the validity of a license storing device carried by a user by performing mutual verification between the license storing device and the contents reproducing device,(Column 15, lines 34-56; Figure 2 [... license server validates or refutes the users key's validity... the users device validates the received license by rendering the program operational]) without authentication of the user. (Column 21, lines 21-45 ; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is independent from the identity of the user]

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art, and that the prior art fail to teach the claimed invention

The examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings." the Examiner states the reference deals with the generalized problem license management and digital rights and therefore the combination of said references would be obvious to a person of ordinary skill in the art.

See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1- 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runje et al.
(US Patent Application Publication US 2001/0032312) in view of Clark (US Patent
6,343,280).

As per claim 1,

Runje et al ('312) discloses license issuing device for writing license information
permitting use of contents in a portable license storing device, the license storing device having
uniquely identifiable device ID and a function of verifying the validity of a partner device, the
license issuing device comprising:

means for producing license information permitting use of contents designated by the
user when the license storing device carried by the user is verified as valid by the verification
means; (Page 4, paragraph 108 [keycard contains a database that holds license information])

first encryption means for encrypting the license information produced by the means for
producing license information with the device ID of the license storing device carried by the user
and writing the encrypted license information in means for producing license information
permitting use the license storing device carried by the user.(Page 6, paragraphs 148-152 [all
communication is encrypted with public key encryption, this includes license information])

Runje et al ('312) does not explicitly disclose by performing mutual verification between
the license storing device and the contents reproducing device, without authentication of the
user. Clark ('280) discloses verification means for verifying the validity of a license storing
device carried by a user by performing mutual verification between the license storing device
and the contents reproducing device,(Column 15, lines 34-56; Figure 2 [... license server
validates or refutes the users key's validity... the users device validates the received license by
rendering the program operational]) without authentication of the user. (Column 21, lines 21-45
; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is
independent from the identity of the user]) It would be obvious to one having ordinary skill in
the art at the time the invention was made to combine the Runje et al system with the Clark
system in order to make the license an effective deterrent against intellectual property theft.

As per claim 2,

Runje et al ('312) discloses the license issuing device of claim 1
wherein the license information includes contents ID for identifying the
contents designated by the user.(Page 4, paragraph 108)

As per claim 3,

Runje et al ('312) discloses the license issuing device of claim 1
wherein the license information includes a contents use condition representing a
restriction during use of the contents designated by the user. (Page 9, paragraph 200)

As per claim 4,

Runje et al ('312) discloses the license issuing device of claim 1
wherein the license information-includes a decryption key for decrypting the contents
designated by the user.(Page 4, paragraph 108)

As per claim 5,

Runje et al ('312) discloses the license issuing device of claim 1

wherein the verification means includes second encryption means for encrypting the device ID of the license storing device carried by the user with a device key possessed by the license storing device carried by the user, (Page 6, paragraph 152)

the first encryption means encrypts the license information with the device ID encrypted by the second encryption means and writes the encrypted license information in the license storing device carried by the user.(Page 6, paragraph 148)

As per claim 6,

Runje et al ('312) discloses the license issuing device of claim 1

wherein the license issuing device connected to the license storing device carried by the user via a network.(Page 5, paragraph 119)

As per claim 7,

Runje et al ('312) discloses a contents reproducing device for decrypting encrypted contents and reproducing the decrypted contents, the contents reproducing device decrypting contents portable license storing device and reproducing the decrypted contents, the license storing device having a uniquely identifiable device ID and a function of verifying the validity of a partner device, the license information having been encrypted with the device ID of the license storing device, the contents reproducing device comprising;

decryption means for decrypting license information stored in the license storing device carried by the user with the device ID of the license storing device when the license storing device carried by the user is verified as valid by the verification means;(Page 9, paragraph 197 [License management device initiates retrieval, decrypts CONTENT_KEY if LICENSE_REQ is valid])

reproduction means for decrypting encrypted contents corresponding to contents of which use is permitted in the license information obtained by the decryption means (Page 8, paragraph 200) and reproducing the decrypted contents.(Page 5, paragraph 120[with a license the user can create a compilation on a CDROM])

Runje et al ('312) does not explicitly disclose by performing mutual verification between the license storing device and the contents reproducing device, without authentication of the user. Clark ('280) discloses verification means for verifying the validity of a license storing device carried by a user by performing mutual verification between the license storing device and the contents reproducing device,(Column 15, lines 34-56; Figure 2 [... license server validates or refutes the users key's validity... the users device validates the received license by rendering the program operational]) without authentication of the user. (Column 21, lines 21-45 ; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is independent from the identity of the user]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Runje et al system with the Clark system in order to make the license an effective deterrent against intellectual property theft.

As per claim 8,

Runje et al ('312) discloses the contents reproducing device of claim 7,

wherein the license information stored in the license storing device carried by the user (Page 4, paragraph 104) includes a decryption key for decrypting the contents of which use is permitted in the license information, (Page 8, paragraph 183)

the reproduction means decrypts the encrypted contents corresponding to the contents of which use is permitted in the license information with the decryption key included in the license information obtained by the decryption means.(Page 5, paragraph 120)

As per claim 9,

Runje et al ('312) discloses the contents reproducing device of claim 7,

wherein the license information stored in the license carried by the user includes contents ID for identifying the contents of which use is permitted in the license information, (Page 4, paragraph 108)

the reproduction means acquires the encrypted contents corresponding to- the contents of which use is permitted in the license information using the contents ID included in the license information obtained by the decryption means.(Figure 31)

As per claim 10,

Runje et al ('312) discloses the contents reproducing device of claim 7, further Comprising;

accumulation means for accumulating encrypted contents, (Figure 31, -- shopping basket ,label 121) and the reproduction means acquires the encrypted contents corresponding to the contents of which use is permitted in the license information obtained by the decryption means from the accumulation means.(Figure 31)

As per claim 11,

Runje et al ('312) discloses the contents reproducing device of claim 7,

wherein the reproduction means acquires the encrypted contents corresponding to the contents of which use is permitted in the license information obtained by the decryption means (Page 6, paragraph 139) via a network.(Page 5, paragraph 119)

As per claim 12,

Runje et al ('312) discloses the contents reproducing device of claim 7,

wherein the license information stored in the license storing device carried by the user includes a contents use condition representing a restriction during use of the contents of which use is permitted in the license information. (Page 9, paragraph 200)

the reproduction means decrypts the encrypted contents corresponding to the contents of which use is permitted in according to the contents use conditions included in the license information obtained by the decryption means and reproduces the decrypted contents.(Page 9, paragraph 200)

As per claim 13,

Runje et al ('312) discloses the contents reproducing device of claim 12, further comprising:

contents use condition contents use condition updating means for updating a included in the license information obtained by the decryption means after the reproduction of the contents by the reproduction means; updated license information production means for producing updated license information including the contents use condition updated by the contents use condition updating means replacing the contents use condition included in the license information obtained by the decryption means; encryption means for encrypting the updated license information produced by the updated license information production means carried by the user;(Page 9, paragraphs 195-196)

Official Notice is taken that "overwriting means for overwriting the license information stored in the license storing device carried by the user with the updated license information encrypted by the encryption means with the device ID of the license storing device" is common and well known in prior art in reference to license management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to overwrite the license information with updated information because would allow the users device to be used multiple times, thus reducing the cost of usage.

As per claim 14,
Runje et al ('312) discloses a contents reproducing device for decrypting encrypted contents and reproducing the decrypted contents, the contents reproducing device decrypting contents based on license information stored in a portable license
storing device and reproducing the decrypted contents, the license storing device having a uniquely identifiable device based on license information stored in a ID and a function of verifying the validity of a partner device, the license information having been encrypted with the device ID of the license storing device encrypted with a device key of the license storing device, the contents reproducing device comprising:

when the license storing device is verified valid encrypting the device ID of storing device to produce the encrypted device ID's decryption means for decrypting the license information stored in the license storing means carried by the user with the encrypted device ID produced by the verification means;(Page 6, paragraphs 148-152 [all communication is encrypted with public key encryption, this includes license information])

reproduction means for decrypting encrypted contents corresponding to contents of which use is permitted in the the license storing device with the device key of the license license information obtained by the decryption means and reproducing the decrypted contents. (Page 5, paragraph 120 [with a license the user can create a compilation on a CDROM])

Runje et al ('312) does not explicitly disclose by performing mutual verification between the license storing device and the contents reproducing device, without authentication of the user. Clark ('280) discloses verification means for verifying the validity of a license storing device carried by a user by performing mutual verification between the license storing device and the contents reproducing device,(Column 15, lines 34-56; Figure 2 [... license server validates or refutes the users key's validity... the users device validates the received license by rendering the program operational]) without authentication of the user. (Column 21, lines 21-45 ; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is

independent from the identity of the user]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Runje et al system with the Clark system in order to make the license an effective deterrent against intellectual property theft.

As per claim 15,

Runje et al ('312) discloses a license issuing method for writing license information permitting use of contents in a portable license storing device, the license storing device having uniquely identifiable device ID and a function of verifying the validity of a partner device, the method comprising the steps of:

when the license storing device carried by the user is verified as valid, encrypting license information permitting use of contents designated by the user with device ID of the license storing device carried by the user and writing the encrypted license information in the license storing device carried by the user. (Page 9, paragraphs 195-196)

Runje et al ('312) does not explicitly disclose verifying the validity of a license storing device carried by a user without authentication of the user. Clark ('280) discloses verifying the validity of a license storing device carried by a user,(Column 15, lines 34-56; Figure 2 [... license server validates or refutes the users key's validity]) without authentication of the user. (Column 21, lines 21-45 ; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is independent from the identity of the user]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Runje et al system with the Clark system in order to make the license an effective deterrent against intellectual property theft.

As per claim 16,

Runje et al ('312) discloses a contents reproducing method for decrypting encrypted contents and reproducing the decrypted contents, based on license information stored in a license storing device and reproducing the decrypted contents, the license storing device having a uniquely identif iable device ID and a function of verifying the validity of a partner device, the license information having been encrypted with the device ID of the license storing device, the method comprising the
steps of:

decrypting license information stored in the license storing device carried by the user with the device ID of the license storing device when the license storing device carried by the user is verified as valid in the step of verify-the validity;(Page 9, paragraph 197 [License management device initiates retrieval, decrypts CONTENT_KEY if LICENSE_REQ is valid])

decrypting encrypted contents corresponding to contents of which use is permitted in the license information obtained in the step of decrypting license information, and reproducing the decrypted contents.(Page 5, paragraph 120[with a license the user can create a compilation on a CDROM])

Runje et al ('312) does not explicitly disclose verifying the validity of a license storing device carried by a user without authentication of the user. Clark ('280) discloses verifying the validity of a license storing device carried by a user,(Column 15, lines 34-56; Figure 2 [...

license server validates or refutes the users key's validity]) without authentication of the user. (Column 21, lines 21-45 ; figure 5 [shows that a license can to assigned to a network mask, the validation of the license is independent from the identity of the user]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Runje et al system with the Clark system in order to make the license an effective deterrent against intellectual property theft.

As per claim 17,
Runje et al ('312) discloses the contents reproducing method of Claim 16,
wherein in the step of decrypting and reproducing, encrypted contents corresponding to contents of which use is permitted in the license information obtained in the step of decrypting license information are (Page 6, paragraph 139) acquired via a network.(Page 5, paragraph 119)

As per claim 18,
Runje et al ('312) discloses the contents reproducing method of Claim 16,
Wherein the license information stored in the license storing device carried by the user includes a contents use condition representing a restriction during use of contents of which use is permitted in the license information,(Page 9, paragraph 200) and in the step of decrypting and reproducing, encrypted contents corresponding to contents of which use is permitted in the license information are decrypted according to the contents use condition included in the license information obtained in the step of decrypting license information, and the decrypted contents are reproduced.(Page 9, paragraph 200)

As per claim 19,
Runje et al ('312) discloses the contents reproducing method of Claim 18, further comprising the steps of:
updating a contents use condition included in the license information obtained in the step of decrypting license information after the reproduction of the contents in the step of decrypting and reproducing; encrypting updated license information including the contents use condition updated in the step of updating replacing the contents use condition included in the license information obtained in the step of decrypting license information with the device ID of the license storing device carried by the user; (Page 9, paragraphs 195-196)
Official Notice is taken that "overwriting the license information stored in the license storing device carried by the user with the updated license information encrypted in the step of encrypting" is common and well known in prior art in reference to license management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to overwrite the license information with updated information because would allow the users device to be used multiple times, thus reducing the cost of usage.

Conclusion

Examiners note; Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is **(571) 272-6713**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687   [Official communications; including After Final communications labeled
"Box AF"]
(703) 308-1396   [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW
June 11, 2005

SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222